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11-16-03

Docket No.: 042390.P5700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Jiang et al.

Assignee: Intel Corporation

Application No.: 09/470,741

Filed: December 20, 1999

For: METHOD AND APPARATUS FOR
PERFORMING VIDEO IMAGE
DECODING

Examiner: J. Wu

Art Group: 2623

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REPLY BRIEF
IN REPLY TO THE EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby submit this Reply Brief ("Reply") in triplicate in reply to the Examiner's Answer mailed July 15, 2003 (hereinafter, "Answer"), and in further support of Appellants' Appeal from the final decision by the Examiner in the above-captioned case.

It is not believed that any fees are due or payable in connection with this submission. However, in event there are any additional fees that are payable, please charge them to Deposit Account No. 02-2666. Additionally, please credit any overcharges of any required fees to Deposit Account No. 02-2666.

I. INTRODUCTION

In the interests of brevity and avoidance of unnecessary duplication of argument, Appellants have chosen not to address in this Reply arguments raised in the Answer that, in substance, have been addressed and rebutted in Appellants' Principal Appeal Brief. Instead, in this Reply, Appellants rebut new points of argument raised by the Examiner that were not previously rebutted in Appellants' Principal Appeal Brief.

II. RESPONSE TO THE EXAMINER'S NEW POINTS OF ARGUMENT

At page 14 of the Answer, the Examiner again acknowledges, as he has done repeatedly during the prosecution of the subject application, that Vetro et al. does not teach "scaling a motion vector in according to [sic, 'accordance with'] a downsampling ratio," as is required in the claims on appeal. Nevertheless, at page 15, the Examiner tries to argue that this limitation "could be read on" Vetro et al.

However, even a casual reading of Vetro et al. indicates that Vetro et al. does not disclose or suggest this limitation of the claimed invention, and the Examiner previously acknowledged this fact repeatedly during the earlier prosecution of the subject application. Now, on the eve of the Honorable Board's decision in this appeal, the Examiner apparently seeks to do an "about face" with respect to this previous acknowledgement. Clearly, this bespeaks the weakness of the Examiner's position on the merits, and in any case, is not supported by Vetro et al.

At pages 17 and 18 of the Answer, the Examiner asserts that the combination of Vetro et al. and Ng "inherently" includes the limitation "the motion vector specifying relative distance of reference data from a macroblock," required in the claims on appeal, for the stated reasons that:

Vetro et al. expressly mentions using MPEQ2 [sic, presumably "MPEG2"] . . .
and Ng expressly mentions using MPEQ [sic, presumably "MPEG"] in column 2,
lines 13-49. Thus, since the definition of motion vector of MPEQ [sic,
presumably "MPEG"] is the relative distance (vertical and horizontal

displacements) from the macroblock being encoded to the matching macroblock-sized area in the reference image and either Vetro or Ng used MPEQ [sic, presumably “MPEG”] standard, the inherency rejection by the Examiner is correct [emphasis removed]. Answer at 17.

Thus, the Examiner appears to argue that the combination of Vetro et al. and Ng “inherently” contains the above claim limitation, merely because Vetro et al. and Ng may contain oblique citations to MPEG standards.¹ This is contrary to law.

As the Honorable Board is well aware, in order to establish a *prima facie* case of obviousness, “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure [emphasis added].” *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As is discussed at length, for example, at page 29 of Appellants’ Principal Brief, contrary to the Examiner’s assertions, the “motion vectors” used in the embodiments disclosed in Vetro et al. and Ng that have been combined by the Examiner to support his obviousness rejections are vastly different from each other in purpose, effect, result, and operation. The same is true of the “motion vectors” used in Bose et al. (Vetro et al., Section 4.3, page 11, Bose et al., col. 17, lines 4-25, and Ng, col. 4, lines 34-39).

Nothing in Vetro et al., Ng, and Bose et al. discloses or suggests the desirability of reconciling these mutually different teachings in a manner that would suggest the claimed invention. Despite these deficiencies in the prior art proffered by the Examiner, the Examiner apparently takes the position that “as long as either Vetro or Ng teaches using MPEQ [sic, presumably ‘MPEG’], the rejection based on the inherency is correct.” Answer at 18. However,

¹ The Examiner also cites page 2 of Appellants’ Specification as supporting the Examiner’s argument. However, in pertinent part, page 2 of Appellants’ Specification merely cites an MPEG specification. Appellants are at a loss to

under applicable law, as the Honorable Board is well aware, unless the prior art, as a whole, including any contraindications contained therein (such as, e.g., mutually contradictory teachings), suggests the desirability of the selective combination proffered by the Examiner, the prior art cannot render obvious the claims on appeal. Thus, the Examiner's position is contrary to law, and cannot serve as a proper basis for rejecting the subject application.

Additionally, although the Examiner has proffered a purported definition of the term "motion vector" as used in MPEG standards, to date, the Examiner has yet to make of record any prior art reference or personal affidavit that evidences the correctness of his purported definition. Such factually supported assertions cannot serve as a proper basis for rejecting the subject application!

At page 17 of the Answer, the Examiner apparently misconstrues Appellants' argument at footnote 1 of page 29 of Appellants' Principal Appeal Brief. As is clear from the footnote, Appellants requested, pursuant to MPEP § 2112 (not MPEP § 2144.03), that the Examiner specifically point out specific passages from the prior art that support the Examiner's assertions that the claimed limitations are inherent to the combination of prior art advanced by the Examiner. Even assuming, *arguendo*, that the prior art may obliquely "mention" MPEG standards, as noted above, under relevant law, this does not make the above claim limitations suggested by, much less inherent to, the prior art combination proffered by the Examiner. It is the Examiner's burden to provide sufficient evidence to support his "inherency" assertions. It is respectfully submitted that, to date, he has yet to satisfy this burden.

At pages 19 and 20 of the Answer, the Examiner apparently argues that his obviousness rejections result from giving the claim language, "motion vector," its broadest reasonable

understand how this portion of Appellants' Specification could be used by the Examiner to support the Examiner's rejections of the subject application, unless the Examiner has relied upon improper hindsight.

interpretation, and by then comparing that language, as so interpreted, to the prior art. However, in construing the claims, the Examiner cannot ignore express limitations in the claims themselves. Additionally, when construing the prior art, the Examiner must not arbitrarily disregard mutually contradictory teachings in the prior art. For the reasons adduced previously, when properly construed, the prior art combination proffered by the Examiner cannot be said to suggest the limitations of the claims.

Lastly, at pages 26 to 27 of the Answer, the Examiner apparently acknowledges that, contrary to the provisions of the MPEP, he has heretofore failed to respond directly to Appellants' repeated requests, pursuant to MPEP § 2112 and § 2144.03, to supply evidence to support the Examiner's still, as yet, unsupported factual assertions. In a vain attempt to excuse his apparent willful failure to follow applicable patent examining procedures, the Examiner relies on a number of colorful, but legally unavailing arguments. The Examiner then goes on to reference a number of statements in previous Office Actions as supporting his argument that he has, nonetheless, "repeatedly and indirectly" provided Appellants with the requested evidence during earlier prosecution. Appellants respectfully submit that these statements, as well as those made by the Examiner at pages 26 and 27 of the Answer characterizing the prior art of record, essentially constitute factually unsupported arguments, and do not qualify as evidence sufficient to satisfy Appellants' previous requests pursuant to MPEP § 2112 and § 2144.03, much less to establish *prima facie* obviousness of the claims on appeal.

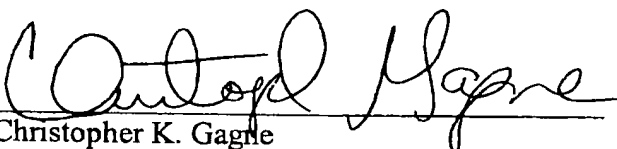
III. CONCLUSION

It is abundantly clear that, in order to reject the subject application, the Examiner has misconstrued the claims on appeal and the prior art. Additionally, the Examiner has failed either to establish *prima facie* obviousness of the claimed invention, or to carry out applicable patent examining procedures. For the foregoing reasons, as well as those presented in Appellants' Principal Appeal Brief, Appellants respectfully request that the Honorable Board of Patent Appeals and Interferences reverse the Examiner's final rejections, and direct that all of the claims on appeal be allowed.

Please charge any shortages and credit any overcharges to Deposit Account number 02-2666.

Respectfully submitted,

Date: August 14, 2003


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